Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HYONG-JU LEE

Appeal No. 1998-1811
Application No. 08/395,193

HEARD: Nov. 29, 2000

Before FLEMING, RUGGIERO, and BARRY, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 2-6 and 10-13. Claims 1 and 7-9 were canceled earlier in the prosecution. An amendment after final rejection filed November 8, 1996, which amended claim 2 and

canceled claim 5, was entered by the Examiner. Accordingly, the rejection of claims 2-4, 6, and 10-13 is before us on appeal.

The claimed invention relates to a method and system for automatically editing programs in an audio and video information copy system. Recorded programs can be detected by coding a recording time of each program on a recording medium together with the video and audio signals of each program. In a single copy program mode, programs recorded in a single periodic time slot are selected for copying, while in a plural program copy mode, a selected successive series of programs recorded at different time slots can be copied.

Claim 2 is illustrative of the invention and reads as follows:

2. In a video and audio information copy system comprising a playback mechanism and a recording mechanism arranged in a single unit, said playback mechanism playing back video and audio signals recorded on a recording medium thereof, said recording mechanism recording externally applied video and audio signals or video and audio signals played back by said playback mechanism on a recording medium thereof, a method of detecting and editing programs of the same time slot from programs recorded on the recording medium of said playback mechanism, comprising the steps of:

selecting a program to be edited, using time information of said video and audio signals, said time information being recorded together with said video and audio signals in a recording mode;

retrieving a program with time information of the program selected at the program selecting step from the programs recorded on the recording medium of said playback mechanism; and

copying the program retrieved at the retrieving step on the recording medium of said recording mechanism;

wherein the program selecting step includes:

a single program selecting step of selecting a plurality of programs of a single periodic time slot using said time information; and

a plural program selecting step of selecting a successive series of programs of different time slots using said time information.

The Examiner relies on the following prior art:

Beaulier	4,568,981	Feb. 04, 1986
Chippendale	4,858,033	Aug. 15, 1989
Lee	5,291,301	Mar. 01, 1994 (filed Jul. 08, 1992)
Matsumi et al. (Matsumi)	5,479,299	Dec. 26, 1995 (filed Feb. 06, 1992)

Claims 2-4, 6, and 10-13 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Chippendale in view of Lee with respect to claims 2-4, adding

Matsumi to the basic combination with respect to claim 6, and adding Beaulier to the basic combination with respect to claims 10-13.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief[1] and Answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in

[1] The Reply Brief filed August 1, 1997 was considered by the Examiner as not being limited to new points of arguments or to new grounds of rejection and was not entered. Accordingly, the arguments in such Reply Brief have not been considered in this appeal.

the particular art would not have suggested to one of ordinary skill in the art the invention set forth in claims 2-4, 6, and 10-13. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in

the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to independent claims 2 and 10, the sole independent claims on appeal, Appellant's primary argument in the Brief centers on the contention that none of the prior art references discloses the claimed "...selecting a plurality of programs of a single periodic time slot..." (claim 2) or "...select programs of the same periodic time slot... (claim 10). After careful review of the applied prior art, in particular the Lee reference specifically relied upon by the Examiner as teaching the claimed "periodic time slot" feature,

we are in agreement with Appellant's position as stated in the Brief.

Our interpretation of Lee coincides with that of Appellant, i.e., while Lee provides for the selecting of programs of different time slots (e.g. Lee, Table 1), there is no suggestion of "selecting programs of a single **periodic** time slot" (Brief, top of page 7, emphasis in original). In reaching this conclusion, we are cognizant of the Examiner's assertion (Answer, pages 6 and 7) that Lee's time slots are inherently periodic since no date information is considered in the Lee reference. We agree with the Examiner that Lee provides for no consideration of date information in relation to the programmed time slots; however, from this factual situation, we reach the opposite conclusion as to the periodic nature of Lee's programmed time slots. While it is proper for an Examiner to consider, not only the specific teachings of a reference, but inferences a skilled artisan might draw from them, it is equally important that the teachings of prior art references be considered in their entirety. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968); W.L. Gore & Assocs., Inc. V. Garlock, Inc., 721 F.2d 1540, 1550, 220 USPQ

303, 311 (Fed. Cir. 1983), cert denied, 469 U.S. 851 (1984).

In our view, on consideration of the disclosure of the operation of Lee's recording system in its entirety, which is silent as to any consideration of date information, we agree with Appellant that Lee's programmed recording time slots cannot be periodic. In the example set forth in Table 1 of Lee, if the programmed time slots were to occur on a periodic basis, e.g., daily, weekly, etc., the fast forwarding feature of Lee which advances a tape so that enough space on a tape is available to record programs of similar type would be essentially nullified. It is apparent to us that there could never be a fast forward amount sufficient to allow enough tape space to record similar type programs that are selected for recording during periodically occurring time slots.

We have also considered the disclosures of the Chippendale, Matsumi, and Beaulier references applied by the Examiner to address the claimed time coding, copy order coding, and background color captioning features, respectively. We find nothing in these references related to

the claimed feature of programmed periodic time slots which would overcome the innate deficiencies of Lee discussed supra.

In view of the above discussion, it is our view, that, since all of the limitations of the appealed claims are not taught or suggested by the prior art, the Examiner has not established a prima facie case of obviousness. Accordingly, the 35 U.S.C.
§ 103 rejection of independent claims 2 and 10, as well as claims 3, 4, 6, and 11-13 dependent thereon, cannot be sustained. Therefore, the decision of the Examiner rejecting claims 2-4, 6, and 10-13 is reversed.

REVERSED

Michael R. Fleming Administrative Patent Judge	)	
Joseph F. Ruggiero Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Lance Leonard Barry Administrative Patent Judge	)	

JFR:tdl

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